

PCT/US99/25984, which contained an Abstract. The Appendix attached herein contains the abstract as found in the PCT application.

II. Claim Rejections under 35 U.S.C. § 103(a)

Claims 1 - 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,093,108 to Pappas et al. ("*Pappas*") in view of U.S. Patent No. 5,212,214 to Kallenbach ("*Kallenbach*") for the reasons set forth on pages 2 - 4 of the present Office Action. Applicants respectfully traverse this rejection.

Pappas teaches quick drying nail enamel compositions. However, as acknowledged by the Examiner, *Pappas* does not teach microspheres. Therefore, the Examiner relies on *Kallenbach* to remedy *Pappas*' deficiencies. In the present Office Action, the Examiner maintains that "there is a motivation to use *Kallenbach*'s composition with *Pappas*" and sets forth various assertions apparently in support of her position. See page 4 of the present Office Action. Applicants disagree for at least the following reasons.

"*Kallenbach* and *Pappas* both teach coating compositions"

In support of the Examiner's assertion that the proposed combination would have been obvious, she first states that "*Kallenbach* and *Pappas* both teach a coating composition." See page 4 of the present Office Action. However, the fact that both references teach coating compositions broadly is not sufficient to establish a prima facie

case of obviousness. The Examiner is required to look at the references as a whole. See M.P.E.P. § 2141.02. Upon considering the references in their entirety, the Examiner must demonstrate that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, in order to establish a prima facie case of obviousness. See M.P.E.P. § 2143.

Applicants maintain that, although *Pappas* and *Kallenbach* may both relate to coating compositions, one of ordinary skill in the art still would not have been motivated to use *Kallenbach*'s coating composition in the nail enamel composition taught by *Pappas*. First, as Applicants have repeatedly noted, *Kallenbach* relates to compositions for coating a substrate that is subsequently cured at a temperature ranging from about 315°C to about 470°C. See col. 9, lines 23-32. *Pappas*' compositions are not cured but rather "dry in a period no greater than three minutes" "at room temperature." See Abstract, col. 14, lines 29-32. There certainly is no motivation to add a composition that cures at high temperature over a long period of time to composition designed to dry at room temperature fairly quickly. In fact, adding *Kallenbach*'s composition, which requires curing at high temperatures, to *Pappas*' compositions would render *Pappas*'s compositions unsatisfactory for their intended use on human nails. Applicants respectfully remind the Examiner that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See M.P.E.P. §

2143.01. Simply put, the fact that *Kallenbach's* compositions are cured at a temperature of at least 315°C teaches away from the use of these compositions in *Pappas' compositions which are for use on human nails*. Accordingly, for at least the foregoing reasons, one of ordinary skill in the art would not have been motivated to make the modification proposed by the Examiner.

"[T]he microspheres taught by *Kallenbach* are well known as a coating ingredient"

Also in support of the Examiner's assertion that the proposed combination would have been obvious, the Examiner asserts that "[t]he microspheres taught by *Kallenbach* are well known as a coating ingredient." See page 4 of the present Office Action. However, Applicants fail to see the relevance of this statement to the issue at hand.

Specifically, the basis of the Examiner's rejection is the proposed "use [of] *Kallenbach's composition* with *Pappas*." See page 4 of the present Office Action. As discussed above, *Kallenbach's* compositions comprise an arylene sulfide polymer resin and a ceramic microsphere filler. See e.g., Abstract. Accordingly, whether or not the microspheres disclosed in *Kallenbach* are "well known as a coating ingredient" is irrelevant to the rejection.

"[T]he argument against the high temperature curing of *Kallenbach* is not persuasive since the claims are directed to coating compositions and a method of application"

As discussed above, Applicants maintain that *Kallenbach*'s teaching of curing the compositions disclosed therein at a temperature ranging from about 315°C to about 470°C negates any motivation to use *Kallenbach*'s composition in *Pappas*' compositions.

In the present Office Action, the Examiner responds, asserting that "the argument against the high temperature curing of *Kallenbach* is not persuasive since the claims are directed to coating compositions and a method of application." See page 4 of the present Office Action. The Examiner continues, asserting that "there is no requirement for a subsequent heat curing in the process step, nor is it a requirement that the nail coating be limited to human nails." *Id.* It is unclear which claims and which "process step" the Examiner is referring to, i.e., those of *Pappas*, *Kallenbach*, or the claims of the presently pending application. Accordingly, Applicants respectfully request clarification so that they may respond to these assertions.

Regardless, Applicants first note that the instant claims of the pending application are irrelevant with respect to the issue of whether there is some suggestion or motivation to combine the reference teachings and whether there is a reasonable expectation of success in making the proposed combination.

Further, Applicants note that the claims of either reference must not be regarded in isolation. Rather, "[a] prior art reference must be considered in its entirety, i.e., as a

whole, including portions that would lead away from the claimed invention.” See M.P.E.P. § 2141.02 (emphasis in original).

Accordingly, the Examiner’s assertions regarding the claims and process step are not dispositive. In contrast, as explained above, the *Kallenbach* reference teaches that “the coating composition is heated in order to cure the polymer components of the coating composition.” See col. 10, lines 23-25. “The arylene sulfide polymer resins used in [*Kallenbach*’s] composition are typically cured by heating the layer of coating to a temperature in the range of from about 315°C to about 470°C.” See col. 10, lines 25-29. Accordingly, *Kallenbach* teaches that a curing step is used to cure the compositions disclosed therein. One of skill in the art could reasonably expect such curing to still be required when *Kallenbach*’s compositions are added to *Pappas*’ compositions. Thus, one would not be motivated to add *Kallenbach*’s composition to *Pappas*’ compositions, which are used for human nails and are designed to dry at room temperature in a few minutes.

Thus, Applicants respectfully maintain that a prima facie case of obviousness has not been made because the cited references fail to provide a motivation to combine reference teachings. Accordingly, for at least the foregoing reasons, Applicants respectfully request the withdrawal of this § 103(a) rejection.

III. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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ABSTRACT

A nail coating composition containing microspheres of varying size and at least one film-forming substance in a cosmetically acceptable medium of use.

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